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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/051,693

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Petra Hingsen-Gehrmann

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11/19/2003

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EXAMINER

EGAN, BRIAN P

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/051,693	Applicant(s) HINGSEN-GEHRMANN ET AL.	
	Examiner Brian P. Egan	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, 6-12, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/55791 (hereinafter WO '791).

WO '791 teaches a tamper-indicating article for attachment to a surface of a substrate comprising an adhesive layer and a retroreflective sheet (see Abstract). The retroreflective sheet comprises a reflective layer (pg. 12, lines 13-18), a non-silicone-based discontinuous release layer adjacent to the reflective layer (note that the release layer is selected from either silicone or non-silicone containing release layers – pg. 11, lines 19-23), and a layer of lenses overlying the release layer and positioned in optical connection with the reflective layer so as to produce retroreflection (pg. 12, lines 4-13). The article exhibits an interlayer cohesive failure at the release layer of the retroreflective sheet when an attempt is made to remove the article from the substrate surface (Fig. 3; pg. 11, line 28 to pg. 12, line 3). The retroreflective sheet further comprises an ink layer, the ink layer located between the reflective layer and the adjacent release layer (“indicia comprising ink” – pg. 8, lines 15-16). The article substantially retains interlayer cohesive failure characteristics when exposed to simulated long-term exposure to heat on a glass windshield (i.e. 40 days at 70°C) (p.25, lines 6-9) – therefore, the article inherently retains interlayer cohesive failure at the less extreme conditions as claimed by the Applicant (24 hours at

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23°C and 50% relative humidity). The retroreflective sheet exhibits a tensile strength at break greater than 7.8 N/mm² and an elongation at break greater than 40% (p.21, Table 1) – note also that the tensile strength and elongation at break are modifiable based on the elasticity or brittleness of the various layers, the adhesion between adjacent layers, the thickness of the layers, and the pattern of the discontinuous release layer, as well as the removal direction, angle, force, and speed and the temperature during removal (pg. 10 line 28 to pg. 11 line 1). The retroreflective sheet has two major surfaces and the adhesive layer is adjacent to the major surface of the retroreflective sheet near the reflective layer and distant to the layer of lenses of the retroreflective sheet (Fig. 2, #40). The reflective layer comprises at least one set of axial markings which are viewable as an image from the front-side of the retroreflective sheet within a limited range of angles (pg. 14 line 23 to pg. 15 line 30). The adhesive layer is a pressure-sensitive adhesive layer wherein the pressure sensitive adhesive layer is a film of pressure sensitive adhesive or a pressure sensitive adhesive coated tape that is removable from the substrate surface without exhibiting cohesive failure by stretching the film or the tape (pg. 4 line 16 to pg. 5 line 17).

WO '791 fails to explicitly teach that the non-silicone based release layer may be positioned between the reflective layer and layer of lenses. Absent demonstration of unexpected results, however, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have rearranged the placement of the non-silicone-based release liner such that it is positioned between the reflective layer and the layer of lenses, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. It is noted that WO '791 teaches the non-silicone-based release liner for

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the purpose of providing a layer that will help provide the user in indicating whether the substrate has been tampered with via interlayer cohesive failure – this function will not be impaired by rearranging the placement of the non-silicone-based release liner layer and the Examiner posits that such rearrangement provides a functionally equivalent result.

3. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO '791 in view of JP 57-044679 (hereinafter JP '679).

WO '791 teaches a tamper-indicating article as detailed above. Although WO '791 teaches that the release layer may be any release material known in the art (pg. 11, line 20) and thus may be selected from silicone and non-silicone containing materials, WO '791 fails to explicitly state that polyester resins, polyacrylate resins, or mixtures thereof may be used as the release material. It is notoriously well known in the art, however, to use polyester release material as evidenced by JP '679 (see Abstract). JP '679 teaches the use of polyester release material for the purpose of providing a coated film that easily and perfectly releases from other substrates (see Abstract). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time Applicant's invention was made to have selected a polyester release material for a tamper-indicating article for the purpose of providing a coated film that easily and perfectly releases from other substrates as taught by JP '679.

Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified WO '791 by replacing the release material with a polyester release material as taught by JP '679 in order to provide a coated film that easily and perfectly releases from other substrates. Furthermore, even in the absence of the teachings of JP '679, it would have been obvious to select either a polyester or polyacrylate resin as the

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release material in WO '791, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious optimization absent demonstration of unexpected results. *In re Leshin*, 125 USPQ 416.

Response to Arguments

4. Applicant's arguments with respect to claims 1-4, 6-12, and 17 have been considered but are moot in view of the new ground(s) of rejection.

Pursuant to the Applicant's amended claims, the Examiner has withdrawn the 35 U.S.C. 112, second paragraph rejections from the previous office action.

In response to the Applicant's argument that there is no suggestion to combine the teachings of WO '791 and JP '679 in rejecting the claim 5 limitations, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA 1969). Here, the combination of references taken as a whole suggest to one of ordinary skill in the art that not only may non-silicone based release liners be used in a retroreflective tamper indicating article, but that the use of a polyester release material provides a coated film that easily and perfectly releases from other substrates – thereby allowing for a clear indication as to where cohesive failure occurred and ultimately indicating that the

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retroreflective article has been tampered with. Therefore, the Examiner maintains that it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have combined the teachings of the aforementioned references, and thus maintains the validity of the 35 U.S.C. 103(a) rejection of Claim 5.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Egan whose telephone number is 703-305-3144. The examiner can normally be reached on M-F, 8:30-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on 703-308-4251. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


BPE 11/12/03


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772 11/14/03